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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
097448,606	11/24/99	BONICEL	056881

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SUGHRUE MION ZINN MACPEAK & SEAS PLLC
2100 PENNSYLVANIA AVENUE N W
SUITE 800
WASHINGTON DC 20037-3213

EXAMINER
NGUYEN, C

ART UNIT
2831

PAPER NUMBER
8

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
09/448,606

Applicant(s)
Jean-Pierre Bonicel

Examiner
First Last

Group Art Unit
1234



☒ Responsive to communication(s) filed on May 4, 2001

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-12 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-12 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2831

DETAILED ACTION

Claim Rejections - 35 U.S.C. § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 4, 6, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okazato et al. (4,723,832) in view of Kazuya (JP 1-276507).

Okazato et al. discloses a telecommunications cable that is structurally reinforced by incorporating armoring having one layer of wires (2) wherein the layer of wires includes steel wires (claims 1&6). Okazato et al. also discloses a tube (1) that forms a concentric layer of the cable and is obtained from a sheet of steel (claims 4&8)

Okazato et al. does not disclose the steel wires and the steel sheet, each being covered in a layer of stainless (claims 1,2,4,6,8&10). Kazuya discloses a composite steel wire in which a steel core is covered by a layer of stainless steel (4). It would have been obvious to one skilled in the art to modify the steel wires and the steel sheet of Okazato et al. by covering each steel wire and the steel sheet with a stainless steel layer as taught by Kazuya to further protect the wires and the sheet since stainless steel is a known highly corrosion-resistant material.

Art Unit: 2831

3. Claims 3, 5, 7, 9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okazato et al. in view of Kazuya as applied to the claims above, and further in view of Applicant's own disclosure (page 4, lines 7-16).

Re claims 3, 5, 7 and 9, it would have been obvious to one skilled in the art to use the composite steel material sold under the registered trademark NUOVINOX for the wire and the tube of the Okazato et al. cable since this material is commercially available and can be drawn into a wire or a tube. In the case of a wire form, the wire can be used as reinforcing wires or armoring wires as disclosed by the applicant (page 4, lines 7-16).

Re claims 11 and 12, the NUOVINOX composite steel wire comprises the steel core directly contacting the layer of stainless steel.

Response to Arguments

4. Applicant's arguments filed May 04, 2001 have been fully considered but they are not persuasive.

Applicant argues that the present invention is directed to a telecommunication or power transport cable that is structurally reinforced with armoring. Okazato et al., on the other hand, discloses a composite cable for both electrical and optical, and the conductors carry electrical transmission. In response, the fact that the composite cable of Okazato et al. for both electrical and optical does not exclude the reference in rejecting the claimed cable which is a telecommunication or power cable. Moreover, it's the fact that the conductors 2 of Okazato et

Art Unit: 2831

al. comprise steel, they are considered reinforcing wires with additional electrical transmitting function. Furthermore, it has been held that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Applicant also argues that it would not have been motivated to replace the conductors 2 of Okazato et al. with the ground cable of JP'507. In response, the Office Action did not replace the conductors 2 of Okazato et al. with the ground cable of JP'507, instead the JP'507 is used only to support the position of using a stainless steel coating on the outer surface of a wire since stainless steel is a known highly corrosion-resistant material. Applicant then argues that the examiner has ignored one of the most important problems with stainless steel that is its very high cost. In response, the stainless steel in the modified Okazato et al. is just a coating and is not used as core wire for all the wires, further the fact of the material having a high cost would not affect the claim rejection.

With respect to claims 4 and 8, applicant argues that the examiner has not set forth where either applied reference discloses a tube that forms a concentric layer of the cable. In response, Okazato et al. discloses a tube (1) that forms a concentric layer of the cable and is formed from a

Art Unit: 2831

sheet of metal (col. 4, lines 31-33). Applicant also argues that using applicant's own disclosure to reject the claims are improper. Examiner agrees with the applicant that using the applicant's own disclosure to reject the claims is improper. However, examiner uses a portion of the applicant's own disclosure which describes a known to reject the claim and not the applicant's own disclosure describing his own invention.

Applicant finally argues that a composite steel tube made from a stainless steel filled with ground steel particles that are compressed under high pressure within the tube, then placed in a furnace, heated, and drawn to a desired section is not compatible for use as a ground wire as disclosed in JP'507. In response, the previous Office Action did not use the composite steel tube made from a stainless steel filled with ground steel particles that are compressed under high pressure within the tube, then placed in a furnace, heated, and drawn to a desired section for the ground wire of JP'507, but instead the composite steel tube as stated above is used for the armoring wires and tube of Okazato et al.

Summary

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 2831

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Communication

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau N. Nguyen whose telephone number is (703) 308-0693.

A handwritten signature in black ink, appearing to read "Chau N. Nguyen", with a long horizontal flourish extending to the right.

Chau N. Nguyen

Patent Examiner

June 8, 2001